

## Sound marks

Signs consisting of a sound which are capable of distinguishing the goods or services of one undertaking from those of other undertakings and are capable of being represented graphically are registrable as trade marks (section 3(1) and (2)).

### Representation and description

If the applicant is seeking protection for a mark which consists of a sound (“sound mark”), this should be indicated on the application form, by ticking the appropriate box on Form T2 and by completing Form T2A. Otherwise, the application will be examined as if it were a word or device mark (e.g. in the form of musical notation).

As sound marks cannot be perceived visually, the graphical representation of a sound mark has to define clearly what constitutes the mark as applied for, so that the precise subject of the protection afforded by the registered mark can be determined. To be able to determine the precise nature of a mark on the basis of its registration, its graphic representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.

In *Shield Mark BV v Kist* [2004] Ch. 97, ECJ, it was held that a written description such as “the first nine notes of Für Elise or a cockcrow”, lacks precision and clarity and therefore does not make it possible to determine the scope of the protection sought. Similarly, a mere sequence of notes (such as E, D#, E, D#, E, B, D, C, A), which is neither clear, nor precise, nor self-contained, does not make it possible, in particular, to determine the pitch and the duration of the sounds forming the melody in respect of which registration is sought and which are essential parameters of knowing the melody and accordingly, of defining the trade

mark itself. The requirement for graphical representation of a sound mark is met where it is represented by a staff divided into bars and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals, e.g. sharp (#), flat (b) and natural (♮). If the musical instrument used to produce the sound is an element of the mark, this should also be stated in the application.

*Example 1*

“The mark consists of a sound.”



*Example 2*

“The trade mark is a sound mark consisting of 5 consecutive notes, namely ABCED.”



### Example 3

“The mark consists of the spoken words HI SA MI TSU superimposed over musical sounds in the key of D major, namely, the melody notes, e, a, e and 2 f sharp notes.”



A description in words alone unaccompanied by a graphical representation of the mark is insufficient. Requirements of graphical representation are not met by a written description of the sound such as the sign composes a particular piece of music, or a list of the notes of which it is comprised, or the sound an animal makes. Simple sequential musical notation, without indications as to timing and pitch, will not meet the necessary requirements.

All in all, the representation of the mark must be such that it is certain, easily viewable and can be determined from the graphical representation precisely what the sign is without the need for supporting samples. However, the Registry welcomes and encourages the submission of a sound recording of the mark applied for if the applicant considers it will assist examination of the mark. If submitted, such a recording will be used for reference purpose only by the Registry. Specifically, it will not be treated as or form part of the graphical representation of the sound mark. The graphical representation of the sound mark remains as the sole basis on which the registrability of the mark will be assessed.

Since any sound recording submitted does not form part of the representation of the mark or the application, there can be no amendment of the mark or its graphical representation on the basis of any discrepancy between the recording and the graphical representation of the mark. For the same reason, the sound recording does not form part of the trade mark records for public search and inspection purposes.

## **Registrability of sounds as trade marks**

The criteria for assessing the distinctive character of a sign which consists of a sound are no different from those to be applied to other types of mark. The registrability of a sound mark must, like words or other types of trade marks, depend upon whether the sound is capable of identifying the goods or services as originating from a particular undertaking, and thus distinguishing it from other undertakings.

However, the average consumer does not necessarily perceive sound marks in the same way as other categories of signs and this may make it more difficult to establish that they are distinctive. For example, a simple note or a series of musical notes is unlikely to be recognised as a trade mark in respect of goods which can emit sound. Mobile phones and computers, for instance, often emit a single bleep or series of musical notes when turned on and off. Sounds of that sort often precede announcements or indicate, for instance, that the piece of equipment has been turned on (or off) or has responded to an input or action on the part of the user. Other examples of sounds that would be considered non-distinctive include the “pop” of a cork in relation to champagne, a “ping” sound in relation to microwave ovens or the retail of microwaves, the sound of glass breaking for glass or windscreen repair services, or the sound of a chain saw for chain saw repair services or retail of chain saw.

Nowadays, promotions of goods or services are often conducted through broadcasting on television and radio, or at promotion booths. Consumers are generally not accustomed to perceiving a sound emitted in the course of an advertisement or promotion as an indication of trade origin, because sounds or music are often used in advertising when a product or service is promoted. Consumers may perceive the sound or music merely as background music or as a means to draw their attention to the advertisement or promotion. For example, a jingle or a catchy melody does not normally serve to identify a certain computer game, not to mention one which comes from a single trade source. Rather, consumers are more likely to perceive the jingle or melody as the background music of the games.

It is also unlikely that a complete song or a lengthy piece of musical notation would function as a trade mark. Applications to register whole or large sections of classical pieces are likely to face objection under section 11(1)(b) on the ground that they are not likely to be taken as a trade mark. Even if a particular sound or piece of music is familiar to the public, this does not necessarily mean that the sound is sufficiently distinctive as to be capable of distinguishing the applicant's goods or services.

Sounds which serve in trade or business to designate the kind, quality, function, or other characteristic of the goods or services claimed cannot be accepted. For example, consumers are likely to perceive the "Wedding March", which is the music commonly used at wedding ceremonies, to be indicative of wedding services and the "rev" sound of a vehicle engine to be indicative of vehicle sales or automotive repair and maintenance services. *Prima facie* objection should be raised under section 11(1)(b), (c) or (d) as appropriate.

In most cases, evidence of acquired distinctiveness will be required. The following are examples of sound marks that would not be accepted without evidence of acquired distinctiveness:-

- a) very simple pieces of music consisting of only 1 or 2 notes;
- b) music (such as "The Blue Danube") commonly used as chimes by ice cream vans (for ice cream etc);
- c) children's giggling for child care services, paediatric medical services or goods and services aimed at children;
- d) jingles commonly associated with amusement arcade machines (for such machines and entertainment services);
- e) well known popular music in respect of entertainment services, including amusement park services.

Where the mark contains a non-distinctive sound but is combined with other distinctive elements, such as words, it will be considered as a whole.

Copyright issues associated with music pieces normally require evidence to resolve and so would normally be dealt with at opposition proceedings.

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